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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,414	01/08/2002	Michael Joseph Calderaro	AUS920010786US1	1316
40412	7590	07/15/2005	EXAMINER	
IBM CORPORATION- AUSTIN (JVL)			LE, NANCY LOAN T	
C/O VAN LEEUWEN & VAN LEEUWEN			ART UNIT	
PO BOX 90609			PAPER NUMBER	
AUSTIN, TX 78709-0609			3621	

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/042,414	Applicant(s) CALDERARO ET AL.	
	Examiner NANCY LOAN T. LE	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,8,9,11-15 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-6, 8-9, 11-15, and 17-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is responsive to the amendment filed on March 28<sup>th</sup>, 2005 for application for patent originally filed on January 8<sup>th</sup>, 2002.

### ***Status of Claims***

2. Claims 1, 4, 8, 11, 14 and 17 have been amended. Claims 3, 7, 10, 16 and 20 have been cancelled; No new claim has been added. Claims 1-2, 4-6, 8-9, 11-15, and 17-19 have been examined and are currently pending.

### ***Drawings***

3. The drawings filed on 01/08/2002 are accepted by the examiner.

### ***Specification and Claims***

4. Objection to the specification and claim 8 has been withdrawn.

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground of rejection.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

Claims 1-2, 4-6, 8-9, 11-15, 17-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wheeler et al., U.S. Patent Publication No. 2003/0177361 A1, published on September 18, 2003.

As per claims 1 and 14, Wheeler et al. disclose a method/computer program product for tracking surplus reduction actions, said method comprising:

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- receiving a surplus reduction action from a user, wherein the user is an employee, and wherein the surplus reduction action includes a surplus acknowledgement (*i.e., a supply company receiving a purchase order from a purchase agent/employee of a business – see [0104]*);
- identifying a user identifier corresponding to the user [0103-0104];
- providing benefits data to the employee in response to receiving the employee's surplus acknowledgement (*i.e., the supply company providing an invoice in response to receiving the purchase agent's purchase order - see [0106]*).

Wheeler et al. does not expressly show a *method of tracking surplus reduction actions* including receiving “a surplus reduction action from a user, and wherein the surplus reduction action includes a surplus acknowledgement”; and further does not expressly shows “storing the user identifier and data corresponding to surplus reduction action in a non-volatile storage area”, nor “providing benefits data to the employee in response to receiving the employee's surplus acknowledgement”.

The “surplus reduction action, wherein the surplus reduction action includes a surplus acknowledgement”, and the “benefits data to the employee” which qualifies as descriptive material since it is directed to the content of data, not structure, or an action, or step. This step, however, does not depend on the content of ‘the surplus reduction action’, and is done the same regardless how this descriptive material/data is being used. Therefore, the method has not changed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include any type of information/data in the user's request taught by Wheeler et al. because the subjective interpretation of what is being included in the user's request, do not patentably distinguish the claimed method.

It is understood here that “storing the user identifier and data corresponding to the surplus reduction action in a non-volatile storage area” step is inherently included in the process of the method -- particularly, in the input/output process, *i.e.*, capturing/storing (capturing/saving) the input data, the user identity verification/confirmation, or the processed data in a medium in which such information (data) is not cleared off (lost) as the power is cut off, for later execution or use.

However, these differences are only found in the non-functional descriptive material and are *not functionally* involved in the steps recited. The receiving identifying/verifying, and storing user's identifier

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steps would be performed the same regardless of the user's input/requested data. Thus, this descriptive material will *not* distinguish the claimed method from the prior art in terms of patentability.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to receive a request/input from a user for any type of data. Because such data does *not functionally* relate to the steps in the method claimed, and because the subjective interpretation of the data does *not patentably* distinguish the claimed method.

As per **claims 2, 9 and 15**, Wheeler et al. disclose the method/information handling system/computer program product of claims 1, 8 and 14, respectively, further comprising:

- receiving a digital signature from the user [0024, 0104];
- authenticating the digital signature [0024, 0104]; and
- storing the digital signature in the non-volatile storage area (understood, for the same reasons explained in claim 1).

As per **claims 4, 11 and 17**, Wheeler et al. disclose the method/information handling system/computer program product of claims 1, 9 and 14, respectively, further comprising:

- sending the employee a non-compete agreement (*i.e., the purchase agent sending the supply company a purchase order – see [0104]*);
- receiving a digital signature from the employee corresponding to the non-compete agreement (*i.e., the supply co. receiving a digital signature corresponding to the purchase order from the purchase agent – see [0104]*); and
- storing the employee's digital signature in the non-volatile storage area (understood, for the same reasons explained in claim 1).

As per **claims 5, 12 and 18**, Wheeler et al. disclose the method/information handling system/computer program product of claims 4, 11 and 17, respectively, further comprising:

- identifying one or more surplus employees that have confidential knowledge of an organization (*i.e., as the supply co. received the purchase order, it's identifying the purchase agent and other info. corresponding to the purchase agent – see [0104, 0106]*); and

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- writing a non-compete indicator to a non-compete data storage area corresponding to the identified surplus employees, wherein the non-compete agreement is sent to surplus employees in response to the identification (*i.e., writing something/data to a storage area is interpreted as 'storing' or 'saving' data to a storage area, is understood for the same reasons explained in claim 1*).

As per claims 6, 13, and 19, Wheeler et al. disclose the method/information handling system/computer program product of claims 5, 12 and 18, respectively, further comprising:

- selecting the group of identified surplus employees (*i.e., selecting the group of identified purchase agents – see [0104]*);
- analyzing digital signatures received from one or more of the identified surplus employees (*i.e., analyzing the purchase order and its corresponding digital signature – see [0104-0106]*);
- determining based on the analysis which of the identified surplus employees have not provided digital signatures in response to non-compete agreements (*i.e., determining based on the analysis which items of goods the purchase agent is authorized to buy – see [0105]*); and
- sending a reminder notification to the determined group of surplus employees (*i.e., the supply co. sending an invoice to the company of the purchase agent – see [0106]*).

As per claim 8, Wheeler et al. disclose an information handling system comprising:

- one or more processors (understood, inherently included in a computer);
- a memory accessible by the processors (understood, inherently included in a computer);
- a non-volatile storage area accessible by the processors (understood, inherently included in a computer);
- a tracking tool for tracking surplus reduction actions, the tracking tool including:
  - ♦ means for receiving a surplus reduction action from a user, wherein the user is an employee and wherein the surplus reduction action includes a surplus acknowledgment (please see citation & explanation in claim 1);

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- ♦ means for identifying a user identifier corresponding to the user (please see citation & explanation in claim 1);
- ♦ means for storing the user identifier and data corresponding to the surplus reduction action in the nonvolatile storage area (please see citation & explanation in claim 1); and
- ♦ means for providing benefits data to the employee in response to receiving the employee's surplus acknowledgement (please see citation & explanation in claim 1).

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **NANCY LOAN T. LE** whose telephone number is **(571) 272-7066**. The examiner can normally be reached on Monday-Thursday, 6am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **JAMES P. TRAMMELL** can be reached on **(571) 272-6712**. For official/regular communication, the fax number for the organization where this application or proceeding is assigned is **(703) 872-9306**. For informal/draft communication, the fax number is **(571) 273-7066 (rightfax)**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through

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Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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*[Signature]*  
**PRIMARY PATENT EXAMINER**